

MS PETITION
Docket No.: 4830-0111PUS1
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Staffan SOLEN et al.

Application No.: 10/825,428

Confirmation No.: 9891

Filed: April 16, 2004

Art Unit: 2876

For: METHOD AND DEVICE FOR RECORDING
OF DATA

Examiner: S. H. Lee

PETITION UNDER 37 C.F.R. § 1.181
TO WITHDRAW THE HOLDING OF ABANDONMENT

MS Petition

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Notice of Abandonment dated October 5, 2006, Applicants hereby respectfully petition under the provisions of 37 C.F.R. § 1.181 and MPEP § 711.03(c) for a decision to withdraw the holding of abandonment due to failure to receive a new Office Action.

Description of the Facts:

1. The examiner issued a Final Office Action dated February 27, 2006 applying a prior WO publication to Andreasson¹ authored by the assignee. This rejection was based on Section 102(b) and relied nearly exclusively on claims of the prior WO publication.

¹ WO 01/93183, hereinafter "Andreasson".

2. In a personal interview dated May 25, 2006 it was ascertained that the Examiner's rejection based on Andreasson was based on an erroneous scan of Andreasson by the PTO. The PTO scan of this reference incorrectly included what appears to be the pending claims of the present application, pages not present in the published version of this reference.

3. In view of this clear error occasioned by PTO scanning, the Examiner, Seung H. Le, on May 25, 2006, issued an interview summary record stating:

"The Examiner agreed to withdraw the outstanding office action mailed out on February 27, 2006."²

4. Applicants received a Notice of Abandonment dated October 5, 2006 that indicates that this application was abandoned in view of the Applicants' failure to respond to an Office Action mailed on February 27, 2006.

Discussion:

Although the Office Action dated February 27, 2006 was received by Applicants' attorneys, during an interview with the Examiner on May 25, 2006, the Examiner agreed to withdraw the outstanding Office Action dated February 27, 2006 and issue a new Office Action in view of the fact that the reference twice applied by the Patent Office, that is Andreasson erroneously scanned in the record to include applicants own claims, did not really exist. To date, no new Action has been received from the U. S. Patent and Trademark Office, with the exception of the Notice of Abandonment dated October 5, 2006.

² A copy of this interview summary statement is attached hereto as Exhibit I

1. EVIDENCE

Since the Examiner agreed, in an official Patent and Trademark Office communication to withdraw the application, the undersigned understood that no response to the withdrawn Office Action was required by the Applicants. It was the understanding of the undersigned, in view of the discussions of the present application and the applied prior art at said interview, that a new Office Action would be issued by the Examiner in place of the February 27, 2006 Office Action which was withdrawn.

2. TERMINAL DISCLAIMER

☒ The present application was filed on or after May 29, 2000. Accordingly, no Terminal Disclaimer is necessary. It is noted that the present Petition is being timely filed within two (2) months of the mailing date of the Notice of Abandonment. Accordingly, no reduction in patent term adjustment should be made, in accordance with the provisions of 37 C.F.R. § 1.704(c)(4).

In view of the above-described facts, it is respectfully submitted that the abandonment of the present application was unavoidable and due solely to Applicants' reasonable reliance on the statement made by the Examiner in the Interview Summary (Form PTOL-413) dated May 25, 2006 that the Office Action dated February 27, 2006 was withdrawn. The present Petition is timely filed for this purpose.

In view of the statement made by the Examiner in the Interview Summary, it is believed that no petition fee is necessary in connection with this Petition.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fee required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: December 4, 2006

Respectfully submitted,

By 

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Attachment: Exhibit I – Copy of Interview Summary

Interview Summary

Application No.

10/825,428

Applicant(s)

SOLEN ET AL.

Examiner

Seung H. Lee

Art Unit

2876

All participants (applicant, applicant's representative, PTO personnel):

(1) Seung H. Lee.(3) Mr. M. Mutter (REG. NO. 29,680).

(2) _____

(4) _____

Date of Interview: 25 May 2006.Type: a) ☐ Telephonic b) ☐ Video Conferencec) ☒ Personal [copy given to: 1) ☒ applicant 2) ☐ applicant's representative]Exhibit shown or demonstration conducted: d) ☐ Yes e) ☐ No.

If Yes, brief description: _____

Claim(s) discussed: _____

Identification of prior art discussed: _____

Agreement with respect to the claims f) ☐ was reached. g) ☐ was not reached. h) ☐ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: The Examiner agreed to withdraw the outstanding office action mailed out on February 27, 2006.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN A NON-EXTENDABLE PERIOD OF THE LONGER OF ONE MONTH OR THIRTY DAYS FROM THIS INTERVIEW DATE, OR THE MAILING DATE OF THIS INTERVIEW SUMMARY FORM, WHICHEVER IS LATER, TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.


Examiner's signature, if required

Summary of Record of Interview Requirements

Manual of Patent Examining Procedure (MPEP), Section 713.04, Substance of Interview Must be Made of Record

A complete written statement as to the substance of any face-to-face, video conference, or telephone interview with regard to an application must be made of record in the application whether or not an agreement with the examiner was reached at the interview

Title 37 Code of Federal Regulations (CFR) § 1.133 Interviews

Paragraph (b)

In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111, 1.135. (35 U.S.C. 132)

37 CFR §1.2 Business to be transacted in writing.

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary Form for each interview held where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the interview recordation procedures below. Where the substance of an interview is completely recorded in an Examiner's Amendment, no separate Interview Summary Record is required.

The Interview Summary Form shall be given an appropriate Paper No., placed in the right hand portion of the file, and listed on the "Contents" section of the file wrapper. In a personal interview, a duplicate of the Form is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephone or video-conference interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the interview rather than with the next official communication.

The Form provides for recordation of the following information:

- Application Number (Series Code and Serial Number)
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (telephonic, video-conference, or personal)
- Name of participant(s) (applicant, attorney or agent, examiner, other PTO personnel, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). Note: Agreement as to allowability is tentative and does not restrict further action by the examiner to the contrary.
- The signature of the examiner who conducted the interview (if Form is not an attachment to a signed Office action)

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview of each case. It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview.

A complete and proper recordation of the substance of any interview should include at least the following applicable items:

- 1) A brief description of the nature of any exhibit shown or any demonstration conducted,
- 2) an identification of the claims discussed,
- 3) an identification of the specific prior art discussed,
- 4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the Examiner,
- 5) a brief identification of the general thrust of the principal arguments presented to the examiner,
(The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.)
- 6) a general indication of any other pertinent matters discussed, and
- 7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete and accurate, the examiner will give the applicant an extendable one month time period to correct the record.

Examiner to Check for Accuracy

If the claims are allowable for other reasons of record, the examiner should send a letter setting forth the examiner's version of the statement attributed to him or her. If the record is complete and accurate, the examiner should place the indication, "Interview Record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.